

REMARKS

Claims 1-8 are pending in the application. Claims 1-8 are rejected.

35 U.S.C. §103:

Claims 1-4 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ojima et al. (U.S. Patent 6,447,271 [hereinafter "Ojima"]) in view of Appleyard et al. (U.S. Patent 6,491,131 [hereinafter "Appleyard"]).

Ojima is applied for disclosing a motor having a rotating shaft and bearings 5, as shown in Fig. 1. The Examiner then cites the hydraulic pump of Fig. 15, while acknowledging that Ojima *does not* teach or suggest elastic bodies supporting the bearings. Appleyard is cited for disclosing a body 16 for supporting the bearing 9. The Examiner also cites the body 15 of Appleyard for pressing the bearing.

One skilled in the art would not have been motivated to combine the elastic bodies of Appleyard with Ojima, without a teaching or suggestion that Ojima needs such extra parts, which would undoubtedly lead to increased costs, additional manufacturing operations, superfluous parts, and a modification to accommodate such parts, which is clearly not taught or suggested.

In particular, Appleyard is directed to an electric power assisted steering system in which a motor is adapted to provide assistance torque to an output shaft 12 through a worm gear 13 (see Abstract). Appleyard discloses that prior devices have suffered from the input shaft not forming a proper fit with the specifically disclosed worm gear and wheel gear. Therefore, when driving the vehicle on rough roads, a rattle occurs between the worm gear and wheel gear. (See, col. 1, lines 60-67 of Appleyard.) Appleyard, therefore, uses an element 14, as shown in Fig. 1, to

address his particular, unique situation. Fig. 1 also discloses a spring 16 that applies a force to an end face of the bearing 9. As one skilled in the art will appreciate, a combination of a worm gear and wheel gear has a particular design used for transferring a torque, such that the gears mesh in a distinguishing manner.

One skilled in the art would not have gratuitously combined the biasing means of Appleyard with Ojima, without a need that justifies the inevitable detrimental aspects associated with a redesign, increased costs, etc. As the Examiner appreciates, a rejection cannot be predicated on the mere identification of individual components of claimed features. (*See In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).) Rather, particular findings *must* be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* It is clear that whether references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).)

Appleyard discloses that its biasing means is used for a particular application wherein the worm gear is required to be properly mated with the wheel gear. However, Ojima does not utilize a worm/wheel gear and, therefore, does not suffer from the detrimental meshing aspects of the worm/wheel gear configuration. It naturally follows that one skilled in the art would not have found it necessary to utilize the biasing means of Appleyard with Ojima because the desirability of such biasing means (i.e., to reduce rattle between the worm and wheel gear) is clearly not applicable to the Ojima. Ojima does not suffer from the engagement problem found

in Appleyard, nor would one have complicated the design of Ojima in the absence of an overriding need to do so.

Therefore, one would not have combined Appleyard with Ojima based on the present teachings as a whole, such that the rejection of claims 1-4 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 5 and 7

Claims 5 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ojima in view of Appleyard, and further in view of Watanabe et al. (6,561,306).

The Examiner acknowledges that Ojima and Appleyard fail to teach or suggest a second elastic body in the form of a disk spring. Watanabe is applied for allegedly disclosing an elastic body 23, as described in col. 8, lines 18-19. Applicant respectfully submits that the additional application of Watanabe fails to make up for the lack of motivation to combine Ojima and Appleyard, such that the rejection of claims 5 and 7 should be withdrawn.

Claim 6

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ojima in view of Appleyard and Watanabe, and further in view of Eda et al. (6,044,723 [hereinafter “Eda”]).

The Examiner acknowledges that Ojima, Appleyard and Watanabe do not disclose the elastic body recited in claim 6 and, therefore, cites Eda. The Examiner asserts that Eda discloses a second elastic body 321 including a body 322, which axially press a bearing. Applicant respectfully submits that Eda fails to make up for the deficiencies in Ojima and Appleyard, such that the rejection of claim 6 under 35 U.S.C. § 103(a) should be withdrawn.

Response Under 37 C.F.R. § 1.111
U.S. Application No. 10/743,726

Attorney Docket # Q79154

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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